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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,939	02/09/2004	Haim Emil Dahan	09420.0001-00000	8623
22852 7590 09/24/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER SCHELL, LAURA C	
			ART UNIT 3767	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/774,939

Applicant(s)

DAHAN ET AL.

Examiner

Laura C. Schell

Art Unit

3767

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 4,5,8,12-15,19,20,23 and 27-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,7,9-11,16-18,21,22,24-26 and 31-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/1/05-8/28/07</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Species A (Figs. 3-6) in the reply filed on 9/4/2007 is acknowledged. The traversal is on the ground(s) that all the independent claims are generic and that there is no burden on the examiner since the claims directed to different species are dependent claims. This is not found persuasive because even though claims directed to different species are written as dependent claims, they still must be searched and claims directed to different species may require searching in different classes and subclasses, therefore the election of species is still necessary and proper. However, the examiner does agree with Applicant's arguments that all the independent claims are generic.

The requirement is still deemed proper and is therefore made FINAL.

Claims 4, 5, 8, 12-15, 19, 20, 23 and 27-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 9/4/2007. Claims 4 and 19 are also being withdrawn as both claims recite "a pressure delivery pathway", which is not disclosed in Species A, it is instead disclosed in Fig. 8, which is part of Species C, and therefore claims 4 and 19 are withdrawn.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the check-valve in claims 11 and 26 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, 7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosenfeld (US Patent No. 5,827,191). Rosenfeld discloses a method of measuring fluid flow from a fluid source to a baby's mouth through a nipple (abstract) comprising: providing a feeding pathway for fluid flow from the fluid source to the baby's mouth, wherein the feeding pathway has a first opening in communication with the fluid source and a second opening in communication with the baby's mouth (Fig. 3 discloses the nipple and the path of fluid flow for the feeding pathway. Fig. 5 further discloses the feeding pathway (13), wherein it flows from the fluid source (breast) to the baby's mouth (out through apertures (9) in Fig. 3), and the feeding pathway has a first opening in communication with the fluid source (col. 3, lines 43-46 disclose that there are three passages leading between the fluid source and the baby's mouth, each is labeled as 13 in Fig. 5. Therefore one of these passages can be considered the feeding pathway, as the fluid flows from the source to the baby's mouth) and a second opening in communication with the baby's mouth (the exit point of each stream of 13 in Fig. 5 is the second opening, alternatively, openings 9 in Fig. 3 can also be considered the second opening);

Providing an indicator pathway for indicating the amount of fluid provided to the baby's mouth through the feeding pathway, wherein the indicator pathway has a first opening in communication with the fluid source and a second opening in communication with the baby's mouth (Fig. 3 discloses the nipple and the path of fluid flow for the indicator pathway. Fig. 5 further discloses the indicator pathway (13), wherein it flows from the fluid source (breast) to the baby's mouth (out through apertures (9) in Fig. 3), and the indicator pathway has a first opening in communication with the fluid source (col. 3, lines 43-46 disclose that there are three passages leading between the fluid source and the baby's mouth, each is labeled as 13 in Fig. 5. Therefore one of these passages can be considered the indicator pathway, as the fluid flows from the source to the baby's mouth and also pass through indicating element in Fig. 5 that detects the flow and indicates the flow via element 7 in Figs. 2 and 3, also described in col. 3, lines 33-35 and lines 13-17) and a second opening in communication with the baby's mouth (the exit point of each stream of 13 in Fig. 5 is the second opening, alternatively, openings 9 in Fig. 3 can also be considered the second opening),

whereby the amount of fluid drawn into the indicator pathway is indicative of the amount of fluid drawn into the feeding pathway (Fig. 5 discloses that the amount drawn into any of pathways 13 is therefore indicative of the amount drawn into the other pathways as well).

In reference to claim 6, Rosenfeld discloses that the feeding pathway and the indicator pathway are integral to the nipple (Fig. 3).

In reference to claim 7, Rosenfeld discloses providing gradation along the indicator pathway to indicate the amount of fluid that has been provided to the baby's mouth through the feeding pathway (Figs. 4 and 5).

In reference to claim 9, Rosenfeld discloses that the fluid comprises breast milk, and the feeding pathway and the indicator pathway are adapted to receive the breast milk from a mother's breast (Fig. 2).

Claims 16, 21, 22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosenfeld (US Patent No. 5,827,191). Rosenfeld discloses an apparatus comprising: providing a feeding pathway for fluid flow from the fluid source to the baby's mouth, wherein the feeding pathway has a first opening in communication with the fluid source and a second opening in communication with the baby's mouth (Fig. 3 discloses the nipple and the path of fluid flow for the feeding pathway. Fig. 5 further discloses the feeding pathway (13), wherein it flows from the fluid source (breast) to the baby's mouth (out through apertures (9) in Fig. 3), and the feeding pathway has a first opening in communication with the fluid source (col. 3, lines 43-46 disclose that there are three passages leading between the fluid source and the baby's mouth, each is labeled as 13 in Fig. 5. Therefore one of these passages can be considered the feeding pathway, as the fluid flows from the source to the baby's mouth) and a second opening in communication with the baby's mouth (the exit point of each stream of 13 in Fig. 5 is the second opening, alternatively, openings 9 in Fig. 3 can also be considered the second opening);

an indicator pathway for indicating the amount of fluid provided to the baby's mouth through the feeding pathway, wherein the indicator pathway has a first opening in communication with the fluid source and a second opening in communication with the baby's mouth (Fig. 3 discloses the nipple and the path of fluid flow for the indicator pathway. Fig. 5 further discloses the indicator pathway (13), wherein it flows from the fluid source (breast) to the baby's mouth (out through apertures (9) in Fig. 3), and the indicator pathway has a first opening in communication with the fluid source (col. 3, lines 43-46 disclose that there are three passages leading between the fluid source and the baby's mouth, each is labeled as 13 in Fig. 5. Therefore one of these passages can be considered the indicator pathway, as the fluid flows from the source to the baby's mouth and also pass through indicating element in Fig. 5 that detects the flow and indicates the flow via element 7 in Figs. 2 and 3, also described in col. 3, lines 33-35 and lines 13-17) and a second opening in communication with the baby's mouth (the exit point of each stream of 13 in Fig. 5 is the second opening, alternatively, openings 9 in Fig. 3 can also be considered the second opening),

whereby the amount of fluid drawn into the indicator pathway is indicative of the amount of fluid drawn into the feeding pathway (Fig. 5 discloses that the amount drawn into any of pathways 13 is therefore indicative of the amount drawn into the other pathways as well).

In reference to claim 21, Rosenfeld discloses that the feeding pathway and the indicator pathway are integral to the nipple (Fig. 3).

In reference to claim 22, Rosenfeld discloses gradations along the indicator pathway to indicate the amount of fluid that has been provided to the baby's mouth through the feeding pathway (Figs. 4 and 5).

In reference to claim 24, Rosenfeld discloses that the fluid comprises breast milk, and the feeding pathway and the indicator pathway are adapted to receive the breast milk from a mother's breast (Fig. 2).

Claims 31-34 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosenfeld (US Patent No. 5,827,191). Rosenfeld discloses a method of indicating suction from a baby's suckling, comprising: receiving suction from a baby's mouth (abstract); providing the suction to at least a first pathway and a second pathway (Fig. 5 discloses three pathways, labeled as 13; col. 3, lines 33-35 and 43-46); and indicating in the second pathway the presence of the suction (milk flowing in any of the pathways turns the propeller which starts the calculations and then displays the volumes on display (7), thus this indicates suction).

In reference to claim 32, Rosenfeld discloses drawing fluid from a fluid source into the first pathway and the second pathway (col. 3, lines 43-46).

In reference to claim 33, Rosenfeld discloses that indicating in the second pathway the presence of suction comprises: indicating the presence of suction by the amount of fluid drawn into the second pathway (col. 3, lines 14-16).

In reference to claim 34, Rosenfeld discloses providing gradations along the second pathway to indicate the amount of fluid drawn into the second pathway (Fig. 5).

In reference to claim 36, Rosenfeld discloses that the amount of fluid drawn into the second pathway is indicative of the amount of fluid drawn into the first pathway (Fig. 5 discloses that the amount drawn into any of pathways 13 is therefore indicative of the amount drawn into the other pathways as well).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, 3, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenfeld (US Patent No. 5,827,191). Rosenfeld discloses the method and device substantially as claimed, including the two pathways (13), however, Rosenfeld does not disclose that the first pathway (indicator pathway) is substantially smaller in cross-section and substantially longer than the second pathway (feeding pathway). It would have been obvious to one of ordinary skill in the art at the time of the

invention to have arranged the cross sectional areas and lengths of the pathways so that the first pathway is smaller in cross-sectional area and longer in length, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claims 10, 11, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenfeld (US Patent No. 5,827,191) in view of Buckley et al. (US Patent No. 6,109,100). Rosenfeld discloses the device and method substantially as claimed except for the fluid source being a bottle and the presence of a check valve to prevent backflow of fluid. Buckley, however, discloses a device and method for measuring fluid flow from a fluid source to a baby's mouth through a nipple (Figs. 1, 2 and 5; abstract) where the fluid source is a bottle (21). Buckley further discloses a check valve (35) to prevent backflow of fluid. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Rosenfeld device with a check valve and to be applied to bottle fluid source, in order to provide a device that can be used during bottle feeding, not just breastfeeding, and in order to provide a device that accurately measures and indicates the flow.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenfeld (US Patent No. 5,827,191) in view of Bommarito et al. (US Patent No. 6,741,523). Rosenfeld discloses the device substantially as claimed except for a color

code in the fluid pathway to indicate presence of fluid. Bommarito, however, discloses color codes for fluid pathways to indicate the presence of fluid in the pathways (col. 27, lines 32-35). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Rosenfeld with the color-coded fluid presence indicator, as taught by Bommarito, in order to provide a device with multiple indicators that are easily read and understood by the average individual.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura C. Schell whose telephone number is (571) 272-7881. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3767

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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LCS

KEVIN C. SIRMONS
SUPERVISORY PATENT EXAMINER

Kevin C. Sirmons